

APPLICATION No. 09/985,828  
RESPONSE UNDER 35 U.S.C. § 1.111  
Attorney Docket No.: Q67041

acknowledged all claims to foreign priority and the receipt of a certified copy of the priority documents.

#### Double Patenting Rejection

With respect to the rejection, claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of a co-pending Application No. 09/983,749. This application has published as US Publication No. 2002-0048394-A1. Applicant respectfully traverses this obviousness-type double patenting rejection in view of the following comments.

The proper standard for determining whether a claim should be rejected for reasons of obviousness-type double patenting is set forth in the MPEP § 804.II.B.1. As explained there, an analysis of obviousness-type double patenting “parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination.” Specifically, the prevailing test on the issue of obviousness-type double patenting is whether any claim in the application defines merely an obvious variation of an invention claimed in the patent. Any obvious-type double patenting rejection should make clear, first, the differences between the inventions defined by the conflicting claims, and, second, the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. See MPEP § 804.II.B.1.

The Examiner has not set forth any reasoning why one of ordinary skill in the art, having reviewed claim 1 of the co-pending application, would have considered claim 1 of the above-identified application an obvious variation.

Despite the burden remaining with the Patent Office, in order to expedite the prosecution of the present application, this provisional rejection is traversed as follows. Claim 1 of the above-identified application recites: a setting unit which automatically sets reference elements to measure a geometric feature of an object. Claim 1 of the co-pending application fails to teach or suggest any setting unit for automatically setting reference elements.

In claim 1 of the co-pending application only measurement points for the subject image are set up. That is, claim 1 of the co-pending application only uses measuring points and a reference-image outputting means for outputting a reference-image that provides suggestions for the positions of the measuring points. Claim 1 of the co-pending application, however, only discloses outputting a reference-image and setting measurement points. Claim 1 of the co-pending application does not teach or suggest setting reference elements. In claim 1 of the co-pending application only measuring points are set up.

In addition, claim 1 of the present application provides a measurement processing apparatus for measuring a geometric feature of an object image, whereas claim 1 of the co-pending application recites a measurement processing apparatus for geometrically measuring an image that includes an outputting means. In other words, claim 1 of the present invention is not an obvious variation of claim 1 of the co-pending application. Accordingly, it is appropriate and necessary for the Examiner to withdraw this double-patenting rejection of claim 1.

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Allowable Subject Matter

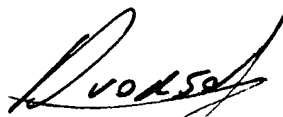
Applicant thanks the Examiner for indicating that claims 2-8 contain allowable subject matter. Applicant respectfully holds in abeyance the rewriting of claims 2-8 until arguments presented with respect to claim 1 have been considered.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Nataliya Dyerson  
Registration No. 56,616

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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